

### **REMARKS/ARGUMENTS**

Favorable reconsideration of this application, as currently amended and in light of the following discussion, is respectfully requested.

Claims 5 and 9-11 are presently pending in this application, Claim 5 having been amended by the present amendment.

In the outstanding Office Action, Claims 5 and 9-11 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite; and Claims 5 and 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Research Disclosure 2001 (hereinafter “Research Disclosure”) in view of any one of SaNogueira, et al. (U.S. Patent 6,190,645) or Industry Circular (hereinafter “Industry Circular”).

First, Applicant acknowledges with appreciation the courtesy of a personal interview granted to Applicant’s representative on October 2, 2008. During the interview, the outstanding issues were discussed and arguments in support of the claims’ patentability over the cited references were presented. Those discussions are reiterated below.

Regarding the rejection under 35 U.S.C. §112, second paragraph, as discussed during the interview, Claim 5 has been amended to remove the phrase “with passage of time,” and thus the pending claims are now believed to be in compliance with the requirements of the statute.

Before addressing the rejection based on the cited references, a brief review of Claim 5 is believed to be helpful. Claim 5 is directed to *a method for suppressing smell change or odor generation in a cosmetic* and recites “preparing a composition including at least one surfactant having an oxyethylene group; and adding a suppressant comprising tert-butanol to said composition, the suppressant suppressing smell change or odor generation caused by the at least one surfactant, wherein the at least one surfactant comprises at least one material selected from the group consisting of materials represented by the following general formula

(1):  $[R^1(OCH_2CH_2)_n-OSO_3]^- M^+$  wherein  $R^1$  represents a linear or branched alkyl group having 7 to 21 carbon atoms or a linear or branched alkenyl group having 7 to 21 carbon atoms,  $n$  represents an integer of 1 to 30, and  $M$  represents Na, K,  $NH_4$ , or triethanolamine; materials represented by the following general formula (2):  $R^2CO-NH(CH_2CH_2O)_mH$  wherein  $R^2$  represents a linear or branched alkyl group having 7 to 21 carbon atoms or a linear or branched alkenyl group having 7 to 21 carbon atoms, and  $m$  represents an integer of 1 to 10; materials represented by the following general formula (3):  $R^3CO-N(CH_2CH_2OH)_2$  wherein  $R^3$  represents a linear or branched alkyl group having 7 to 21 carbon atoms or a linear or branched alkenyl group having 7 to 21 carbon atoms, and tert-butanol is added in an amount of 0.01 to 1,000 ppm based on a total weight of the composition.”

By adding a suppressant comprising tert-butanol in such an amount, the cosmetic composition produces less smell change over time, and undesired odor or smell change caused by the surfactants over time is effectively suppressed, as shown in the previously filed attached Declaration. The declaration also shows that a composition containing an excessive amount of tert-butanol, *i.e.*, more than 1,000 ppm, produces unfavorable odor.

The Office Action states that “it would have been obvious ... that the SD 40 alcohol of the cosmetic compositions of Research Disclosure contain t-butanol and even through the reference fails to teach the claimed method for suppressing smell change odor generation with passage of time in a cosmetic, it is implicit from the teachings of US 645 and Industry Circular that the SD 40 alcohol containing tert-butanol is effective in inhibiting the suppression of odor or smell change of oleath-20 or laureth surfactants of Research Disclosure.” The Office Action further states that “[w]hile the references fail to teach the amount of butanol, denaturing alcohol utilizes a significant portion of butanol (according to Industry Circular).” Applicant respectfully traverses as follows.

First, it is respectfully submitted that Research Disclosure merely lists a large number of exemplary compositions for various hair protection products and that among those, only two compositions include SD 40 alcohol with surfactants. Moreover, it provides the typical amounts of SD 40 alcohol in the range of *0% to 8%*, and some other compositions contain SD 40 alcohol despite the absence of any surfactants. Nowhere does Research Disclosure describe or suggest that some surfactants in the compositions may cause smell change or odor, nor does it states that SD 40 alcohol suppresses such smell change or odor. Considering the reference in its entirety, simply giving the range of *0% to 8%* of SD 40 alcohol, not tert-butanol, and having the majority of compositions with *no* SD 40 alcohol, Research Disclosure does not provide any inferences or suggestions of the desirability of doing what Applicant has done.<sup>1</sup> Also, it is respectfully submitted that without addressing the smell change or odor generated by certain surfactants, no reasonable expectation of success can be found in Research Disclosure.<sup>2</sup> Thus, Research Disclosure cannot, even under a *prima facie* case of obviousness, teach or suggest a *method* of suppressing smell change or odor caused by certain surfactants by adding tert-butanol, or more likely than not, it is believed to lead away from adding SD 40 alcohol.<sup>3</sup>

Furthermore, SaNogueira, et al. and Industry Circular only describe that SD 40 alcohol is ethanol denatured with tert-butanol and do not disclose or suggest that SD 40 alcohol would suppress smell change or odor generated by certain surfactants.

Based on the aforementioned reasons, Applicant respectfully submits that the reasoning of the obviousness rejection advanced in the Office Action is believed to be a product of hindsight guided by Applicant's disclosure and that none of Research Disclosure,

---

<sup>1</sup> *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985); *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004). "The court emphasized that the proper inquiry is whether there is something in the prior art as a whole suggest the *desirability* ..., not whether there is something in the prior art as a whole to suggest that the combination is the most desirable combination available."

<sup>2</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>3</sup> *Id.*

SaNogueira, et al. and Industry Circular teaches or suggests a *method* for suppressing odor caused by surfactants by adding certain effective amounts of tert-butanol as recited in Claim 5.

Therefore, Research Disclosure, SaNogueira, et al. and Industry Circular clearly fail to teach or suggest “adding a suppressant comprising tert-butanol to said composition, the suppressant suppressing smell change or odor generation caused by the at least one surfactant ..., wherein ... tert-butanol is added in an amount of 0.01 to 1,000 ppm based on a total weight of the composition” as recited in Claim 5. Accordingly, Applicant respectfully requests that the outstanding obviousness rejection of Claim 5 be withdrawn.

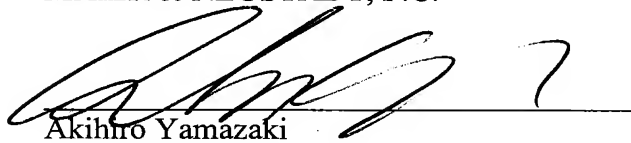
Applicant also wishes to point out that on February 27, 2007, to provide evidence of non-obviousness, Applicant has submitted the declaration under 37 C.F.R. §1.132 showing that by having a suppressant including the amount of tert-butanol in the range of 0.01 to 1,000 ppm based on a total weight of the composition, the cosmetic composition produces less smell change over time while a composition containing an excessive amount of tert-butanol, *i.e.*, more than 1,000 ppm, the composition produces unfavorable odor.

For the foregoing reasons, Claim 5 is believed to be allowable. Furthermore, since Claims 9-11 depend from Claim 5, substantially the same arguments set forth above also apply to these dependent claims. Hence, Claims 9-11 are believed to be allowable as well.

In view of the discussions presented above, Applicant respectfully submits that the present application is in condition for allowance, and an early action favorable to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Akihito Yamazaki', written over a horizontal line.

Akihito Yamazaki  
Attorney of Record  
Registration No. 46,155

Customer Number

**22850**

Tel: (703) 413-3000

Fax: (703) 413 -2220  
(OSMMN 06/04)

AY/mda

I:\ATTY\AKY\24s\240114\240114US\_AME\_3.DOC